

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 140, 142-151, and 176-183 are pending in the application, with claims 140 and 179 being the independent claims. Claims 140, 142, 144-146, 148, 150, 151, and 179-183 are sought to be amended. New claims 184-187 are sought to be added. Support for the amendments to claims 140 and 179-183, and the addition of new claims 184-187, can be found, for example, at page 17, line 8 - page 19, line 9 and page 29, line 22 - page 30, line 14 of the as filed specification. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Information Disclosure Statement

As noted in Applicant's previous Reply, the CD-ROMs submitted on September 30, 2005 were brought to Applicant's attention by defendants during the course of two litigations, namely

Teleshuttle Technologies, L.L.C. et al v. Microsoft Corporation, U.S.D.C. ND CA CIVIL CASE #: 5:04-cv-02927-JW, and

Teleshuttle Technologies, L.L.C. et al v. Microsoft Corporation et al, U.S.D.C. ND CA CIVIL CASE #: 5:04-cv-02928-JW.

The CD-ROMs submitted in the IDS of September 30, 2005 were presented out of an abundance of caution and in the form received from the opposing parties in the two litigations. Applicant does not assert that either he or his representatives have reviewed each

listed document in detail in connection with the herein claimed invention nor is the Applicant aware that any of the listed documents are more material to the claims of this application than are the references that have already been considered by the Examiner.

Rejections under 35 U.S.C. § 112

Claim 140 was rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action alleges that the feature “independently published portable storage media,” as recited in previously presented claim 140, is not described in the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventor, at the time the application was filed, had possession of the claim. (Office Action pp. 3, 4.) Applicant respectfully traverses.

To satisfy the written description requirement, all that is required is “reasonable clarity.” (MPEP § 2163.02.) An adequate description may be made in any way through express, implicit, or even inherent disclosures in the application, including words, structures, figures, diagrams, and/or formulae. (MPEP §§ 2163(I), 2163.02.)

U.S. Patent Application No. 08/641,010 (“the ‘010 application”), which the present application incorporates by reference, describes an online service provided by CompuServe that allows a CD-ROM information product to be used in conjunction with its online service. (the ‘010 application col. 9, ll. 8-11.) This service, however, is only useable in conjunction with CD-ROM content provided by CompuServe and does not work with independently published CD-ROMs (i.e., CD-ROMs published by different companies and/or people). (the ‘010 application col. 9, ll. 11-17.) Accordingly, as noted in the ‘010 application, such dedicated CD-ROM services do not provide a “satisfactory solution to *independent*

publishers looking for economical update means” for their products because they would be limited, for example, to an inflexible user interface and data management system provided by CompuServe. (the ‘010 application col. 9, ll. 17-24.) Other independent publishers mentioned in the spec include, for example, Newsweek, Cinemania, complete Baseball, and Counterpoint.

Based on the foregoing, Applicant submits that the specification describes the claimed invention (specifically the feature “independently published portable storage media” as recited in previously pending claim 140) in sufficient detail that one skilled in the art can reasonably conclude that Applicant had possession of the claimed invention. Nevertheless, Applicant has amended independent claim 140 to clarify the subject matter therein. Amended claim 140 recites “wherein the first portable storage medium and the second portable storage medium are provided by different independent publishers.” Accordingly, both previously presented claim 140 and amended claim 140 comply with the written description requirement. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

In the event that the Office similarly rejects amended claim 140, Applicant respectfully requests, in the interest of its policy of compact prosecution, that the Office explain how the aforementioned portions of the ‘010 application, which the present application incorporates by reference, fail to communicate to a skilled artisan that Applicant possessed the claimed invention.

Rejections under 35 U.S.C. § 103

Claims 140, 142-151, and 176-183 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,347,632 to Filepp et al. ("Filepp") and Applicant's Admission of Prior Art (AAPA). For the reasons set forth below, Applicant respectfully traverses.

Independent claim 140 recites, among other features, an information transport component that enables access at a user station, via a user interface:

to first fixed information content from a first portable storage medium together with first related remote information content from one or more remote information content sources such that the first fixed information content and the first related remote information content are presented by the user interface as a first single collection of information content, and

to second fixed information content from a second portable storage medium together with second related remote information content from one or more remote information content sources such that the second fixed information content and the second related remote information content are presented by the user interface as a second single collection of information content,

wherein the first portable storage medium and the second portable storage medium are provided by different independent publishers,

Filepp and AAPA, alone or in combination, do not teach or suggest at least this feature of claim 140.

As pointed out in the Amendment and Reply of August 6, 2008, Filepp is directed to a method and apparatus for providing applications to a reception system over a network. (Filepp col. 2, ll. 51-68; col. 3, ll. 1-3.) A personal computer is configured as a reception system by the inclusion and running of reception system software that enables applications to be received by the computer over a network. (*Id.*) Specifically, Filepp discloses that applications are sent to a reception system over a network in partitions referred to as objects that are each self-contained and independently operable. (Filepp col. 5, ll. 3-38.) Each

partition is sent “on demand” for execution by the receiving reception system. Filepp purports that the ability to send portions of an application “on demand” increases storage efficiency at a reception system and minimizes response time. (*Id.*)

The reception system software of Filepp provides access to application data stored on diskettes 426, containing reception system software, together with applications retrieved via a network. (Filepp FIG. 1; col. 4, lines 50-57; col. 8, ll. 28-39.) Specifically, Filepp states that “objects representing all or part of partitioned applications may be stored in a user’s [reception system] 400” and that “such objects are either provided on diskettes 426 together with [reception system software] used during the installation procedure or, they are automatically requested by [reception system] 400.” (Filepp col. 8, ll. 28-39.) However, diskettes 426 represent portable storage media from a *single* publisher.

Thus, Filepp does not teach or suggest that the reception system software is used to “enable access . . . to first fixed information content from a first portable storage medium together with first related remote information content from one or more remote information content sources . . . and to second fixed information content from a second portable storage medium together with second related remote information content, . . . wherein the first portable storage medium and the second portable storage medium are provided by different independent publishers” as recited in claim 140.

As noted by the Examiner on page 6 of the Office Action, Filepp further describes the use of an operating system provided on diskettes 428. (Filepp FIG. 1; col. 4, ll. 50-57.) However, Filepp does not teach or suggest that the reception system software enables access to the data stored on diskettes 428, let alone that the reception system software enables access to the fixed information content stored on diskettes 428 “together with . . . related

remote information content from one or more remote information content sources such that the . . . fixed information content and the . . . related remote information content are presented by the user interface as a single collection of information content” as recited in claim 140.

Without acquiescing to the propriety of the asserted combination, the background discussion in the present application does not cure the deficiencies of Filepp discussed above.¹ (Office Action p. 7.) In fact, the portion of the background discussion relied on by the Examiner explicitly states that general-purpose, online, electronic information services “provide no means for the integration of downloaded information with information products offered on disk or CD.” (Specification p. 3, ll. 12-14.)

Thus, like the reception system software and operating system software disclosed in Filepp, the general-purpose, online, electronic information services discussed in the background section do not teach or suggest an information transport component that enables access at a user station, via a user interface:

to first fixed information content from a first portable storage medium together with first related remote information content from one or more remote information content sources such that the first fixed information content and the first related remote information content are presented by the user interface as a first single collection of information content, and

to second fixed information content from a second portable storage medium together with second related remote information content from one or more remote information content sources such that the second fixed information content and the second related remote information content are presented by the user interface as a second single collection of information content,

wherein the first portable storage medium and the second portable storage medium are provided by different independent publishers

¹ Applicant does not admit that the background discussion of the application, relied on by the Examiner, constitutes “admitted prior art.”

as recited in claim 140.

Because the combination of Filepp and the background discussion fails to teach or suggest each and every feature of claim 140, it cannot render that claim unpatentable. Dependent claims 142-151 and 176-178 are likewise not rendered unpatentable over Filepp and the background discussion for at least the same reasons as independent claim 140 from which they depend, and further in view of their own respective features. Accordingly, Applicant respectfully requests that the rejection of claims 140, 142-151, and 176-178 be reconsidered and withdrawn.

Independent claim 179 recites, among other features, “first program logic to enable access, via a user interface, to first fixed information content, from a first portable storage medium, together with first related remote information content from one or more remote information content sources such that the first fixed information content and the first related remote information content are presented by the user interface as a first single collection of information content, and to enable access, via the user interface, to second fixed information content from a second portable storage media together with second related remote information content from one or more remote information content sources such that the second fixed information content and the second related remote information content are presented by the user interface as a second single collection of information content, wherein the first portable storage media and the second portable storage media are provided by different independent publishers.” As noted above, in regard to claim 140, the combination of Filepp and the background discussion does not teach or suggest at least this feature of claim 179.

Because the combination of Filepp and the background discussion fails to teach or suggest each and every feature of claim 179, it cannot render that claim unpatentable. Dependent claims 180-183 are likewise not rendered unpatentable over Filepp and the background discussion for at least the same reasons as independent claim 179 from which they depend, and further in view of their own respective features. Accordingly, Applicant respectfully requests that the rejection of claims 179-183 be reconsidered and withdrawn.

Other Matters

In Applicant's previous Reply dated August 6, 2008, Applicant characterized the claimed feature "information content" as not encompassing application software or software in general. However, Applicant has reviewed the instant specification and notes that this previous characterization of "information content" was made in error and that "information content" as broadly recited in independent claims 140 and 179 may encompass, among other things, software. Accordingly, the statements made in Applicant's previous reply to the contrary are withdrawn.

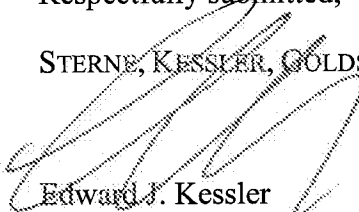
Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, requests allowance of the present application. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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